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10/603,110

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Jay S. Walker

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EXAMINER

EL-ZOOBI, MARIA

ART UNIT

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4178

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/603,110	Applicant(s) WALKER ET AL.	
	Examiner Maria El zoobi	Art Unit 4178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>All</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-16 and 19-22 of U.S. Patent No. 6,597,770. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Application claim 1 and Patent claim 1 are both drawn to the same invention, i.e., a method...

Claim 1 with additional limitation, i.e. “determining at least one communication address....” claims all the limitations of the Patent’s claim1. Although the conflicting

claims are not identical, they are not patentably distinct from each other because both the claim 1 of instant application and the claim 1 of the Patent No. 6,597,770 are almost the same in scope although Patent's claim 1 omits some limitations in Application's claim 1. Therefore, it would have been obvious to one of ordinary skill in the art to modify Patent's claim 1 with the additional limitation so to obtain application's claim 1 as claimed.

Allowance of application claim 1 would result in an unjustified time-wise extension of the monopoly granted for the invention defined by Patent's claim 1. Therefore, obviousness-type double patenting is appropriate.

Application claim 2 corresponds to Patent claim 2.

Application claim 3 corresponds to Patent claim 3.

Application claim 4 corresponds to Patent claim 4.

Application claim 5 corresponds to Patent claim 5.

Application claim 6 corresponds to Patent claims 6-10.

Application claim 7 corresponds to Patent claim 11.

Application claim 8 corresponds to Patent claim 3; it is known that the first person is the person who authorize the transaction and indeed also the person that controls the use of its own account.

Application claim 9 corresponds to Patent claim 3; because it is well known in the art, for the person who authorized the transaction has to be account holder or a joint holder of the account. Therefore, it would have been obvious to one with ordinary skill

in the art, at the time the invention was made to modify the patent claim 3 to include that the first person is a joint holder of the account, to obtain the Application claim 9.

Application claim 10 corresponds to Patent claim 12.

Application claim 11 corresponds to Patent claim 13.

Application claim 12 corresponds to Patent claim 14.

Application claim 13 corresponds to Patent claim 15.

Application claim 14 corresponds to Patent claim 16.

Application claim 15 corresponds to Patent claim 22.

Application claim 16 corresponds to Patent claims 19 and 20; it is inherent that if a communication via video/telephone established between the first and second person, that the second person is associated with a device.

Application claim 17 corresponds to Patent claim 19.

Application claim 18 corresponds to Patent claim 1; because it is well known in the art, that the first person can text message a second person using a telephone with a text messaging capabilities. Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made, to modify the Patent claim 1 to include text message communication between the first and the second person, to obtain the Application claim 18.

Application claim 19 corresponds to Patent claim 20.

Application claim 20 corresponds to Patent claim 21.

Application claim 21 corresponds to Patent claim 21; it is inherent that the communication address will be the phone number when the first person and the second person are communicating via a telephone.

Application claim 22 and Patent claim 22 are both drawn to the same invention, i.e., a method.... Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim 22 of the instant Application and claim 22 of Patent No. 6,597,770 are almost the same in scope although instant Application claim omits some limitations in Patent claim 22. Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made, to modify the Patent claim 22 by omitting some of the limitations so to obtain Application claim 22 as claimed.

Allowance of Application claim 22 would result in an unjustified time-wise extension of monopoly granted for the invention defined by Patent claim 22.

Application claim 23 and Patent's claims 1 and 11 are drawn to the same invention, i.e., a method... These claims are commensurate in scope and differ in the way they were written.

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made , to modify the Patent claims 1 and 11 by rewording the claims, to be like claim 23 in the instant Application.

Allowance of Application claim 23 would result in an unjustified time-wise extension of monopoly granted for the invention defined by Patent claims 1 and 11.

Claims 1-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5, 9-12, 14, and 18-19 of Patent No. 6,327,348.

Application claims 1 and Patent claim 1 are drawn to the same invention, i.e., a method... Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim 1 of the instant Application and claim 1 of the Patent are almost the same in scope, although the instant Application claim 1 omits some limitations in the Patent's claim 1. Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify the Patent's claim 1 by omitting some of the limitations so to obtain Application's claim 1 as claimed.

Allowance of Application's claim 1 would result in an unjustified time-wise extension of monopoly granted for the invention defined by Patent's claim 1. Therefore, obviousness-type double patenting is appropriate.

Application claim 2 corresponds to Patent claim 1.

Application claim 3 corresponds to Patent claim 3.

Application claim 4 corresponds to Patent claim 10.

Application claim 5 corresponds to Patent claim 19.

Application claim 6 corresponds to Patent claim 11.

Application claim 7 corresponds to Patent claim 12.

Application claim 8 correspond to Patent claim 10; it is known that the first person is the person who authorize the transaction and indeed also the person that controls the use of its own account.

Application claim 9 correspond to Patent claim 10; because it is well known in the art for the person who authorized the transaction has to be account holder or a joint holder of the account. Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify the Patent claim 10 to include that the first person is a joint holder of the account, to obtain the Application claim 9.

Application claim 10 corresponds to Patent claim 13.

Application claim 11 corresponds to Patent claim 14.

Application claim 12 corresponds to Patent claim 18.

Application claim 13 corresponds to Patent claims 1 and 2; it is known that the first person that issues the transaction is the owner of the account.

Application claim 14 corresponds to Patent claim 5.

Application claim 15 correspond to Patent claim 9; the second telephone number is associated with the third party, and the communication between the first and the second person is based on the second phone number which is associated with the third person.

Application claim 16 corresponds to Patent claim 1; because it is well known in the art, that if there is a communication between first and a second party that each of

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them should have a communication mean. Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify the Patent claim 1 to include that the communication between the first and the second person is via a device associated with the second person so to obtain the Application claim 16 as claimed.

Application claim 17 corresponds to Patent claim 9; the claim teaches the use of a telephone as a mean of communication between the first and second person.

Application claim 18 corresponds to Patent claim 1; it is well known in the art, that the first person can text message a second person using a telephone with a text messaging capabilities. Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made, to modify the Patent claim 1 to include text message communication between the first and the second person so to obtain the Application claim 18.

Application claim 19 corresponds to Patent claim 9.

Application claim 20 corresponds to Patent claim 9.

Application claim 21 corresponds to Patent claim 9.

Claim 22 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of Patent No. 6,327,348 because

claim 22 with additional limitation, i.e. "receiving a request to authorize a transaction between the 2nd person and a 3rd party...", claims all the limitations of the Patent's claims 1 and 2. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claim 22 of instant application and the claims 1 and 2 of the Patent No. 6,327,348 are almost the same in scope although Patent's claims 1 and 2 omit some limitations in Application's claim 22. Therefore, it would have been obvious to one of ordinary skill in the art to modify Patent's claims 1 and 2 with the additional limitations so to obtain application's claim 22 as claimed.

Allowance of application claim 22 would result in an unjustified time-wise extension of the monopoly granted for the invention defined by Patent's claims 1 and 2. Therefore, obviousness-type double patenting is appropriate.

Claim 23 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of Patent No. 6,327,348 because

These claims differ in scope in that application claim 23 is broader in scope than Patent claims 1 and 2

Therefore, it would have been obvious to one of ordinary skill in the art to modify Patent's claims by omitting some limitations so to obtain application's claim 23 as claimed.

Allowance of application claim 23 would result in an unjustified time-wise extension of the monopoly granted for the invention defined by Patent's claims 1 and 2. Therefore, obviousness-type double patenting is appropriate.

Conclusion: If the Applicant agrees that there exists an obviousness-type double patenting between the Application and the above patents No. 6,597,770 and No. 6,327,348; then the Examiner requests Applicant to provide a Terminal between Application No. 10/603110 and Patent No. 6,597,770; a Terminal Disclaimer between the Application No. 10/603110 and Patent No. 6,327,348 and a Terminal Disclaimer between the Patent No. 6,597,770 and Patent No. 6,327,348.

DETAILED ACTION

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, 12-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bickham et al US (5,530,438) in view of Hird et al US (5,319,701).

Regarding claim 1, Bickham discloses, a method (col. 2, line 58) comprising: associating a first person with an account (col. 3, lines 66-67; the radio system user 126 has a financial transaction)

associating a second person with the account (col. 3, lines 39-40;

the second person 118 engages in this transaction account) receiving a request to authorize a transaction between the second person and a third party (col. 4, lines 34-36).

Bickham does not disclose determining whether the first person desires to communicate with the second person, determining at least one communication address and enabling communication between the first person and the second person based on the at least one communication address if the first person desires to communicate with the second person.

Hird discloses, determining whether the first person desires to communicate with the second person (col. 29, lines 22-26) determining at least one communication address (col. 8, lines 43-47; the telephone number) and enabling communication between the first person and the second person based on the at least one communication address if the first person desires to communicate with the second person (col. 25, line 17 and 37-38 and col. 28, lines 10-25 and col. 7, lines 36-46). Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made, to modify Bickham method, to include a communication between the first and the second party, as taught by Hird, in order to allow for additional verification for the transaction.

Regarding claim 2, Bickham in view of Hird discloses, the method of determining whether the first person desires to communicate with the second person comprises:

receiving from the first person an indication that the first person desires to communicate with the second person (Hird: col. 28, lines 15-19).

Regarding claim 3, Bickham in view of Hird discloses, receiving a signal from the first person, the signal comprising an indication of whether to authorize the transaction; and processing the transaction based on the signal (Bickham: col. 4, lines 33-39).

Regarding claim 4, Bickham in view of Hird discloses, receiving a first signal from the first person (Bickham: col. 4, lines 33-43; the signal is the user message el. 132), the first signal indicating whether to authorize the transaction (col.4, lines 33-43); and transmitting a second signal to the third party (col. 4, lines 33-43; the provider 116 is the third party), the second signal indicating whether the transaction is authorized (col. 4, lines 33-43).

Regarding claim 5, Bickham in view of Hird discloses, receiving data including an identifier that identifies the account (Bickham: col. 3, lines 39-48).

Regarding claim 6, Bickham in view of Hird discloses, in which the identifier comprises at least one of: a credit card number (Bickham: col. 3, lines 41-44), a casino player tracking number, a checking account number, a smart card number, a frequent flyer account number, a payment account number, and a debit card number.

Regarding claim 7, Bickham in view of Hird discloses, the account is a credit card

account (Bickham: col. 4, lines 41-44).

Regarding claim 8, Bickham in view of Hird discloses, the first person is a controlling individual (Bickham: col. 5, lines 37-39; since completion of the transaction is based on the first person “the radio system user” approval; that means he is the controlling individual of the account).

Regarding claim 9, Bickham in view of Harid discloses, the first person is a joint holder of the account (Bickham: col. 4, lines 19-22).

Regarding claim 10, Bickham in view of Harid discloses, the first person is an account holder of the account (Bickham: col. 5, lines 37-39; since completion of the transaction is based on the first person “the radio system user” approval; that means he is the account holder of the account).

Regarding claim 12, Bickham in view of Hird discloses, determining a fee Based on the transaction and charging the fee to the account (Bickham, col. 5, lines 18-23; so the subscriber of the alert service “the radio system user” will be charged for the service).

Regarding claim 13, Bickham in view of Hird discloses, associating the second person comprises:

associating the second person with a credit card, in which the credit card corresponds to the account (Bickham: col. 3, lines 39-43), and in which the first person

owns the account (col. 3, lines 66-67 and col. 4, lines 25-28)

Regarding claim 14, Bickham in view of Hird discloses, determining a duration of the communication (Hird: col. 3, lines 56-59)

determining a monetary amount based on the duration (Hird: col. 3, lines 59-62) and charging the monetary amount to the account (Hird: col. 36, lines 47-49).

Regarding claim 15, Bickham in view of Hird discloses, enabling communication between the first person and the second person via a device that is associated with the third party (Hird: col. 24, lines 20-23; so a live operator “the third party” could verify the process and continue the process by connecting the first and second party together if the first person accepts the call; col. 25, lines 3-10).

Regarding claim 16, Bickham in view of Hird discloses, enabling communication between the first person and the second person via a device that is associated with the second person (Hird: the second person is the caller and the pay phone is the device that is associated with this person; col. 5, line 31 and col. 23, lines 2-3).

Regarding claim 17, Bickham in view of Hird discloses, enabling communication between the first person and the second person via a device that comprises at least one of: a telephone (col. 3, lines 37-40), a pager, a radio device, a personal digital assistant, and a computer.

Regarding claim 18, Bickham in view of Hird disclose, enabling text-based communication between the first person and the second person (Hird: col. 5, lines 30-31).

Regarding claim 19, Bickham in view of Hird discloses, enabling at least one of audio communication and video communication between the first person and the second person (Hird: col. 5, lines 27-29).

Regarding claim 20, Bickham in view of Hird discloses, enabling telephonic communication between the first person and the second person (col. 3, lines 37-39; the pay phone)

Regarding claim 21, Bickham in view of Hird discloses, at least one communication address comprises at least one of:

a communication address that is associated with the first person, a communication address that is associated with the second person, a communication address that is associated with the third party, a telephone number (col. 25, lines 37-38), a pager number, an Internet protocol address, an instant messaging address, and an email address.

Regarding claim 23, Bickham discloses, a method comprising:

receiving an indication of a transaction between a user of a credit card

account and a merchant (col. 3, lines 28-41) in which the transaction is associated with the credit card account (col. 3, lines 42-43)

identifying an account holder of the credit card account (col. 3, lines 66-67 and col. 4, lines 1-2)

receiving from the account holder an indication of whether to authorize the transaction (col. 4, lines 29-43)

Bickham does not disclose, after receiving the indication of the transaction, enabling communication between the account holder and the user.

Hird discloses after receiving the indication of the transaction, enabling communication between the account holder and the user (col. 29, lines 22-26).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made, to modify Bickham method to include communication between the first and the second party, as taught by Hird, in order to allow for additional verification for the transaction.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hird et al US (5,319,701) in view of Bickham et al US (5,530,438).

Regarding claim 22, Hird discloses a method comprising:
receiving an indication of a first person (Hird: col. 28, lines 15-19).

associating the first person with an account (the called person is

associated with the billing account number col.22,lines 14-17)

receiving an indication of a second person (Hird: col. 25, lines 37-38 the second person dials the phone number as indication to have a communication with the first person)

associating the second person with the account (the second user use the same billing account number, col. 23, lines 2-5)

receiving an identifier that identifies the account (Hired: col. 8, lines 58-60).

receiving a request to authorize a transaction between the second person and a third party (Hird: col. 29, lines 22-26).

determining a first communication address that is associated with the first person based on the identifier that identifies the financial account (Hird: col. 8, lines 43-47).

establishing a connection to the first person based on the first communication address (Hird: col. 25, line 17 and 37-38 and col. 28, lines 10-25 and col. 7, lines 36-46).

determining whether the first person desires to communicate with the Second person (Hird: col. 25, line 17 and 37-38 and col. 28, lines 10-25 and col. 7, lines 36-46); and if the first person desires to communicate with the second person:

determining a second communication address that is associated with the second person and enabling communication between the first person and the

second person based on the second communication address (Hird: the second person is the caller and the pay phone is the device that is associated with this person and the address is the phone number of the pay station; col. 5, line 31 and col. 23, lines 2-3).

Hird does not disclose that the account is a financial account.

Bickham disclose that the account is a financial account (col. 3, lines 66-67; the radio system user 126 has a financial transaction; col. 3, lines 39-40; the second person 118 engage in this transaction account and col. 4, lines 34-36; a request to authorized the financial transaction).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify Hird method to include that the transaction is a financial transaction, in order to provide a way for a user of credit/debit account to share the account with other users, so they will be able to use this account after he authorize the transaction.

Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bickham et al US (5,530,438) in view of Hird et al US (5,319,701) and in view of Cucintta (6,081,792).

Regarding claim 11, Bickham in view of Hird discloses, a third party to be involve in the transaction.

Bickham in view of Hird does not disclose that the third party is an automatic teller.

Cucintta discloses that the third part is an automatic teller (Fig. 2)

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to modify Bickham in view of Hird method, so the third party will be an automatic teller machine, in order to allow cash transfer between first and second person .

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria El Zoobi whose telephone number is 571-270-3434. The examiner can normally be reached on Monday-Friday (8AM-5 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hai Tran can be reached on 571-272-7305. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4178

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. E./

/Maria El zoobi/

Examiner, Art Unit 4178

/Hai Tran/

Supervisory Patent Examiner, Art Unit 4178